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No. 03-1187

In the Supreme Court of the United States

ALLOC, INC., BERRY FINANCE N.V., AND VALINGE INNOVATIONS AB, FKA VALINGE ALUMINIUM AB, PETITIONERS

v.

UNITED STATES INTERNATIONAL TRADE COMMISSION, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether the Federal Circuit properly interpreted the displacement and disassembly limitations of patent claims for certain flooring products in light of the specification and prosecution history of those patents.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 3a-40a) is reported at 342 F.3d 1361. The opinion of the United States International Trade Commission (Pet. App. 41a-71a) is unreported.

JURISDICTION

The judgment of the court of appeals was entered on September 10, 2003. A petition for rehearing was denied on November 17, 2003 (Pet. App. 1a-2a). The petition for a writ of certiorari was filed on February 17,

2004 (a Tuesday following a holiday). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

Petitioners Alloc, Inc., Berry Finance N.V., and Välinge Aluminum AB filed a complaint with the United States International Trade Commission alleging that Unilin Décor N.V., BHK of America, Inc., Meister-Leisten Schulte GmbH, Pergo, Inc., Akzenta Paneele + Profile GmbH, Tarkett, Inc., and Roysol violated Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. 1337, in the importation and sale of certain flooring products by reason of infringement of certain claims of U.S. Patents Nos. 5,860,267 (the '267 patent), 6,023,907 (the '907 patent), and 6,182,410 (the '410 patent). The Commission ruled that there was no violation of Section 337 because, *inter alia*, there was no infringement with respect to the patents at issue. The court of appeals affirmed the Commission's ruling.

1. Section 337 requires the Commission to investigate complaints brought by private parties to determine whether imported articles should be barred from entering the United States because of unfair practices in import trade. See 19 U.S.C. 1337. Section 337 investigations are generally based on allegations of infringement of intellectual property rights, usually patent infringement. Section 337 investigations are conducted in the first instance by a Commission administrative law judge (ALJ) pursuant to Section 337, implementing regulations, and the Administrative Procedure Act, 5 U.S.C. 551 *et seq.* After discovery, briefing, and an evidentiary hearing, the presiding ALJ issues an initial determination (ID) on whether there has been a violation of Section 337. The ID is then subject to review by the full Commission (consisting, when fully com-

posed, of six Commissioners), which may adopt, modify, or reverse the ID.

In this case, the dispute between Alloc and respondents turned on a single issue—whether the displacement and disassembly limitations of the Alloc patent claims require "play," *i.e.*, a gap between the locking surface and locking groove of a flooring panel edge lock. Each of the asserted claims recites a displacement or disassembly limitation.[1] If the displacement and disassembly limitations require "play," then respondents' flooring products do not infringe the claims at issue because their products have no "play" in the flooring edge lock. The Commission's ALJ construed the displacement and disassembly limitations of the flooring edge lock claims at issue to require "play" and accordingly found no infringement and no violation of Section 337. See Pet. App. 72a-322a. On review, the Commission adopted the ALJ's construction of the displacement and disassembly limitations of the flooring edge

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[1] Claim 1 of the '410 patent recites a "locking means * * * constructed so as to enable said adjacent panels * * * to be turned * * * in order to unlock said one-way snap lock" (*i.e.*, the disassembly function). See Pet. App. 411a. Claims 1 and 26 further recite an edge lock "for mechanically and releasably locking together" adjacent panels, *id.* at 410a, 415a-416a, and claim 39 recites that the edge lock is "constructed so as to allow mutual displacement of the panels in the direction of the long edges," and "the second mechanical connection along the long edges is so constructed as to allow the locking element to leave the locking groove," *id.* at 419a. Claim 1 of the '907 patent recites "displacing the new panel relative to the second panel," and that the panels are "displaceable in relation to each other in the direction of the adjacent joint edges." *Id.* at 343a, 344a. Claims 19 and 23 of the '267 patent recite "displacing the new one of the panels in its longitudinal direction," and claim 39 recites "displacing the new panel relative to the first panel." *Id.* at 377a, 379a, 388a.

lock claims at issue and determined, based on that construction, that respondents did not violate Section 337. See *id.* at 41a-71a.

2. Alloc appealed, and the court of appeals affirmed the Commission's decision. Pet. App. 3a-40a. The court relied on the established principle that patent claims are not interpreted in isolation but must be construed in light of the specification. Pet. App. 12a, 16a (citing *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996)). The court noted that the balance between interpreting claims in light of the specification, yet avoiding impermissibly importing limitations from the specification, "turns on how the specification characterizes the claimed invention." *Id.* at 16a.

The court found that the specification common to all the patents at issue teaches that the displacement and disassembly limitations of the edge lock require "play." See Pet. App. 13a-17a. The court cited extensively from the specification and found that "play" enables the claimed displacement of floor panels. *Id.* at 13a-15a. The court also noted that all the figures and embodiments disclosed in the asserted patents explicitly show or imply play. *Id.* at 15a. The court further observed that the specification "criticizes prior art floor systems without "play," because in the prior art flooring edge lock systems the flooring panels are "tightly urged against each other." *Ibid.* The specification does not disclose any non-"play" embodiments of the flooring panel edge lock. *Ibid.* The court accordingly concluded that the specification "read as a whole leads to the inescapable conclusion that the claimed invention must include play in every embodiment." *Id.* at 17a.

The court of appeals also found that the prosecution history confirmed its interpretation of the displacement

and disassembly limitations in light of the specification. Pet. App. 18a. It noted that, even though "play" itself is not specifically recited as a limitation in any of the claims at issue, the displacement and disassembly limitations at issue require "play" to perform their claimed functions. The court found that, in a series of application rejections and amendments, the applicant repeatedly emphasized that the unique feature of the flooring panel edge lock, which distinguished the claimed invention from the prior art, was the displacement and disassembly features of the flooring edge lock disclosed in the application. The examiner allowed the patent on the basis of those displacement and disassembly limitations after the applicant had specifically argued that "play" enabled those locking functions. See *id.* at 18a-20a. The court of appeals concluded that, "[b]ecause the applicant invoked play to overcome the prior art, which lacked displacement and disassembly, Alloc cannot now contend that the '621 patent claims a flooring system and method for installing that system without play. The applicant expressly disavowed systems without play during prosecution of the parent '621 application." *Id.* at 20a. See *id.* at 20a-22a.[2]

ARGUMENT

The court of appeals properly interpreted the patents at issue in accordance with the patent laws and the controlling judicial decisions. The court of appeals' ruling that the displacement and disassembly limitations of the patent claims for certain flooring products require "play" is correct and does not conflict with any

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[2] Judge Schall dissented. In his view, the majority should not have relied on the specification because it did not amount to a "manifest exclusion or restriction, representing a clear disavowal of claim scope." Pet. App. 31a-32a.

decision of this Court or any other court of appeals. That fact-based determination presents no issue warranting this Court's review.

1. Congress has granted the Federal Circuit exclusive appellate jurisdiction over a case in which the complaint alleges a claim arising under federal patent law. 28 U.S.C. 1295(a); see *Holmes Group, Inc.* v. *Vornado Air Circulation Sys., Inc.*, 535 U.S. 836 (2002). That court has developed a body of law respecting patent claim interpretation that sets out the role of the patent specification in construing claims. The court of appeals properly applied its decisions on that subject to the facts of this case.

The federal patent laws state that the "specification shall contain a written description of the invention, and * * * shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. 112, paras. 1, 2 (emphasis added). The court of appeals accordingly interprets patent claims in light of the description contained in the specification, *Markman*, 52 F.3d at 979, while taking care to "avoid impermissibly importing limitations from the specification, *Comark Communications, Inc.* v. *Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998)." See Pet. App. 16a. The court followed that approach in this case. See *id.* at 11a-17a.

Contrary to petitioners' contentions (Pet. 11-18), the court of appeals did not "expand[] the relative weight accorded to a patent's specification" (Pet. 11). Rather, the court interpreted the patent claims in light of the patentee's disclosure of the invention in the specification. The court used the specification to assist in determining what the inventor meant by the displacement and disassembly limitations of the claims at issue.

There is nothing novel in the court's approach. To the contrary, the court of appeals' methodology and ultimate decision are consistent with this Court's observation that a patent claim "term can be defined only in a way that comports with the instrument as a whole." *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996).

Petitioners are likewise mistaken in contending (Pet. 14-16) that the court of appeals used the specification to change the meaning of the claims. As this Court has pointed out, "[t]he context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claims; but not for the purpose of changing it, and making it different from what it is." *White* v. *Dunbar*, 119 U.S. 47, 51-52 (1886). The court of appeals followed that instruction. It did not introduce a "play" limitation from the specification into the claims. Rather, the court recognized that the specification made clear that "play" is an essential feature of the invention because it enables the displacement and disassembly features of the flooring edge lock invention described in the claims. Pet. App. 13a. The court also recognized that the "play" described in the specification is not merely a feature of the preferred embodiment, but instead an essential element the invention. *Ibid.* The court of appeals properly considered the specification "only for the purpose of better understanding the meaning of the claim" and "not for the purpose of changing it and making it different from what it is." *Howe Mach. Co.* v. *National Needle Co.*, 134 U.S. 388, 394 (1890).

2. Petitioners are also mistaken in contending (Pet. 22) that the court of appeals "inflated the importance of the prosecution history as a tool in determining claim scope." This Court has held that the patentee bears the

burden of proving that an amendment made during the prosecution of the application before the PTO that narrows a patent claim was not made for a reason that would give rise to estoppel. *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002); *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997). Consistent with those decisions, the court of appeals held petitioners to the patentee's representations made in the application process that "play facilitated its novel system set forth in the revised claims." Pet. App. 20a.

Petitioners cite *Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U.S. 222, 227 (1880), for the proposition that the prosecution history may not be used "to enlarge, diminish, or vary the language of a patent afterwards issued." See Pet. 22-23. That decision, which recognizes that a patentee may be estopped by prosecution history, see *Goodyear*, 102 U.S. at 228, 230, must be read in light of this Court's subsequent decisions in *Festo* and *Warner-Jenkinson*, which provide further elaboration on the relevance of the concept. The Court specifically stated in *Festo* that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process," 535 U.S. at 733, and that the purpose of applying prosecution history estoppel is "to hold the inventor to the representations made during the application process and to the inferences that may reasonably be drawn from the amendment," *id.* at 737-738.

The court of appeals in this case properly held petitioners to representations made during patent prosecution and refused to allow petitioners to recapture non-"play" embodiments of the claimed flooring edge lock that were relinquished for claim allowance. See Pet.

App. 19a-20a. The court properly recognized that petitioners cannot "seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent." *Festo*, 535 US 734. In this instance, the patent applicant distinguished the invention from the prior art that lacked "play," and the patent applicant thereby excluded panels lacking "play" from the scope of the invention.

Petitioners' contention that the court of appeals misapplied the prosecution history rests in large part on their misunderstanding of that history and its relevance. The court of appeals observed that the applicant for the patents at issue surrendered non-play embodiments of the flooring edge lock during patent prosecution by explicitly arguing that the "play" was "important" because "it enables the panels to slide movably with respect to each other" (the claimed displacement function), and enables disassembly of the floor when required. See Pet. App. 18a-19a. The court of appeals properly rejected petitioners' contentions (see Pet. 25) that the applicant broadened the claims at issue by taking the word "play" out of the claims. As the court pointed out, the applicant argued to the PTO that, even though the new claim did not recite "play," "play" exists between the locking groove and the locking surface such that the "displacement of the panels is still facilitated." Pet. App. 20a. In any event, that fact-bound dispute does not warrant this Court's review.

3. Contrary to petitioners' assertions (Pet. 9), there is no "disarray in the Federal Circuit's case law on claim interpretation." As the court of appeals has recognized, there is some inherent tension between the claim construction canon that counsels against creating claims limitations from the specification and the competing canon that a claim must be read in view of its

specification. See *Renishaw PLC* v. *Marposs Societa' Per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998); see also *Comark Communications, Inc.*, 156 F.3d at 1186 ("We recognize that there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification."). Indeed, even the dissenting judge below acknowledged the "very fine line between" these competing considerations. Pet. App. 31a (Schall, J., dissenting). The court's decision properly reconciled those canons by referring to the specification for the limited purpose of better understanding the claims limitations at issue. See *id.* at 11a-12a, 16a.

Petitioners' contention of "disarray" rests on an incomplete account of the Federal Circuit's case law regarding the relevance of the specification and prosecution history in evaluating patent claims. For example, petitioners cite Judge Dyk's concurring opinion in *SciMed Life Systems, Inc.* v. *Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1342–1343 (Fed. Cir. 2001), for the proposition that the Federal Circuit has provided "inadequate guidance" on the role of the specification in construing the claims. Pet. 10. But even if that were so, since the *SciMed* decision, the Federal Circuit has decided *Teleflex, Inc.* v. *Ficosa North America Corp.*, 299 F.3d 1313 (Fed. Cir. 2002), which articulated a clear standard for determining when a claim term should be limited based on the specification and prosecution history. The court stated in *Teleflex* that:

> claim terms take on their ordinary and accustomed meanings unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic re-

> cord [*e.g.*, the specification and prosecution history] using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.

Id. at 1327. See Pet. App. 16a.[3]

The court of appeals properly applied that standard in this case by employing the specification and prosecution history as an aid in construing the displacement and disassembly limitations of the patent claim. The court interpreted those limitations in light of the specification and prosecution history, but avoided impermissibly importing limitations from those sources. See Pet. App. 11a-22a. Further review is unwarranted.

4. Petitioners challenge the court of appeals' decision on several other grounds that are also without merit. For example, petitioners rely on the doctrine of claim differentiation, asserting that, because claim 49 in the '410 patent calls for "play," that limitation should not be read into claim 39 of that patent. Pet. 18-19 (citing *D.M., Inc.* v. *Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985)). But as the Federal Circuit has made clear, "[t]he doctrine of claim differentiation cannot broaden claims beyond their correct scope, determined in light of the specification and the prosecution history and any relevant extrinsic evidence." *Wang Labs, Inc.* v. *America Online, Inc.*, 197 F.3d 1377, 1384 (Fed. Cir.

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[3] See also Gregory J. Gallagher, *Recent Development: The Federal Circuit and Claim Construction: Resolving the Conflict between the Claims and the Written Description*, 4 N.C. J.L. & Tech. 121 (Fall 2002) ("In a recent case, *Teleflex, Inc. v. Ficosa North America Corp.*, the Federal Circuit articulated a comprehensive standard that resolves this conflict [between the claims and the written description in determining the scope of a claim] and provides the appropriate amount of protection to a patentee while providing adequate incentive for innovation.").

1999) (quoting *Multiform Dessicants, Inc.* v. *Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir. 1998)). See *D.M., Inc.*, 755 F.2d at 1574 & n.2 ("Claims are always interpretable in light of the specification and prosecution history of the application that led to the patent.").

Petitioners also describe the '907 and '261 patent claims as "method" claims and rely on this Court's statement in *Smith* v. *Snow*, 294 U.S. 1, 20 (1935), that "[r]espondents do not avoid infringement of the method by varying the details of the apparatus by which they make use of it." Pet. 19-20. But that statement is inapposite here because the "method" that petitioners claim in their '907 and '261 patents requires "play." See Pet. App. 6a-8a, 13a & n.3. As the court of appeals explained, the specification and prosecution history of the patents at issue expressly state that it is the "play" in the flooring lock which "allows" and "enables" the recited displacement and disassembly functions of those method claims. *Id.* at 13a-22a.

Finally, there is no merit in petitioners' suggestion (Pet. 26 n.15) that the court of appeals' decision reflects the minority view of only two Federal Circuit judges. Petitioners requested rehearing en banc, and the full court of appeals denied that petition, with only one recorded vote in favor of en banc review. See Pet. App. 1a-2a. The court of appeals properly concluded that the decision does not warrant further review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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